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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WAYNE W. WANG and JOEY HUANG

Appeal 2008-002533
Application 09/824,491
Technology Center 2100

Decided:[1] May 22, 2009

Before ALLEN R. MACDONALD, JOHN C. MARTIN,
and ST. JOHN COURTENAY III, *Administrative Patent Judges.*

MARTIN, *Administrative Patent Judge.*

DECISION ON APPEAL

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-22, which are all of the pending claims.

We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

A. Appellants' invention

Appellants' invention provides an efficient and useful method for generating transform rules for existing web pages for display and use with a multitude of Internet appliances, such as PCs, mobile phones, PDAs, and television set-top boxes. Specification at 3:4-6. The invention provides a graphical editor that allows the designer to lay out device-specific web pages based upon original web pages that might comprise a web site. *Id.* at 3:6-8.

Appellants' Figure 1 is reproduced below.

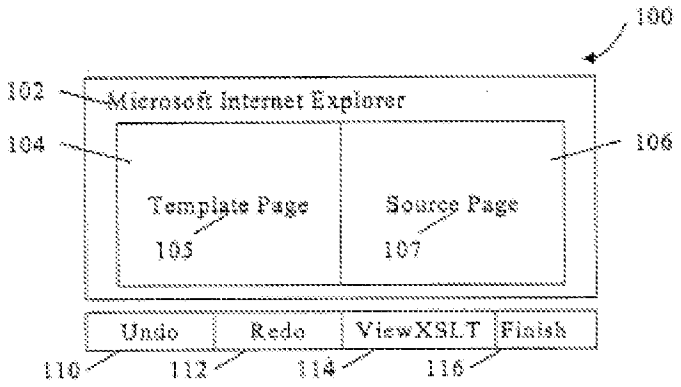

FIG. 1

Figure 1 shows a block diagram 100 of a representative user interface that appears in the client workstation, the user interface consisting of two frames displayed on a browser 102, such as Microsoft Internet Explorer. *Id.* at 11:24-26. The left frame 104 loads the template page 105, and the right frame 106 loads the source page 107. *Id.* at 26-27. For elements in the source page 107, the user can drag and drop the element into the template page 105. *Id.* at 11: 30-31. For elements in the template page 105, certain ones can be modified. *Id.* at 11:31. For the revisable element, the user can move the position of the element in the template page and modify its attributes. *Id.* at 11:31 to 12:2.

Figure 1 also shows that there are at least four buttons (or click-through interface areas) in the user interface: "Undo" 110, "Redo" 112, "ViewXSLT"[2] 114, and "Finish" 116. *Id.* at 12:3-4. When the user clicks Undo, the latest action will be canceled, whereas when the user clicks Redo, the latest undo action will be restored. *Id.* at 12:4-6. When the user clicks ViewXSLT, the client session will request the server session to make the TRG (Transform Rule Generator[3]) generate XSLT according to user actions. *Id.* at 12:6-7. After XSLT is generated, the server session will send XSLT to the client session, which shows XSLT to the user. *Id.* at 12:7-9. When the user clicks Finish, it means that the user wants to finish customizing the current page. *Id.* at 12:9-10.

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[2] XLST means "XSL Translation." Specification 11:3.

The generated transform rules are thereafter applied to the source material by a proxy server or other such device. *Id.* at 10:20-21. The proxy server receives requests from a web-enabled device, retrieves the requested source material from the appropriate web server, and then transforms the source material into the appropriate format for the receiving device by applying the appropriate transform rules. *Id.* at 10:21-24.

B. The claims

Claim 1, the sole independent claim, reads as follows:

> 1. A method for generating a set of transform rules to be used in transforming web-based information from a source page format to a web-enabled receiving device template page format, the transformation occurring in response to a request for the web-based information by the receiving device, the method comprising:
>
> displaying the source page and the template page using a graphical user interface;
>
> identifying elements within the information displayed on the source page and the template page;
>
> recording user actions for arranging the elements on the source page and the template page, the user actions being recorded onto at least two stacks, with the at least two stacks recording different user actions;
>
> using the at least two stacks as the basis for supporting the user actions;

---

[3] Specification at 10:28.

generating chains of elements from the at least two stacks;

providing XSLT from the generated chains; and

generating the set of transform rules for the source page according to the source page URL, the XSLT, and the receiving device.

Claims App., Br. 19.

C. The references and rejection

The rejection is based on the following references:

Keane et al. (Keane)	US 5,481,710	Jan. 2, 1996
Sugiarto et al. (Sugiarto)	US 6,278,449 B1	Aug. 21, 2001
Jamtgaard et al. (Jamtgaard)	US 6,430,624 B1	Aug. 6, 2002

In addition, the Examiner relies on:

Microsoft Word 2000, "Screenshots" (Dec. 31, 1999) at 1-9 (hereinafter "Microsoft Word 2000").

Claims 1-22 stand rejected under § 103(a) for obviousness over Sugiarto in view of Jamtgaard and Keane.

THE ISSUES

Appellants have the burden to show reversible error by the Examiner in maintaining the rejection. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting

the *prima facie* case with evidence of secondary indicia of nonobviousness.")

The issues raised by Appellants' arguments (discussed *infra*) are whether the Examiner erred in:

1. Finding that Sugiarto discloses "recording user actions for arranging the elements on the source page and the template page."

2. Finding that Sugiarto discloses "generating the set of transform rules for the source page according to the source page URL."

3. Finding that Jamtgaard teaches or suggests generating a set of transform rules according to XSLT.

4. Concluding that motivation existed to combine the reference teachings in the proposed manner.

5. Finding that Microsoft Word 2000 discloses "one user action includ[ing] a keystroke" (claims 16-22).

SUGIARTO

Sugiarto's invention allows users to specify the information that is to be received from the internet and the manner in which that information will be displayed on a highly portable internet access device. Sugiarto, col. 1, ll. 63-67.

A configuration file, which is created by the user and stored in a centralized database server, specifies the information the user would like to

retrieve from the network and how that information is to be displayed. *Id.* at col. 2, ll. 17-21. The configuration file can be created using the portable internet access device (e.g., handset 6 in Figure 1) (*id.* at col. 2, ll. 21-23) or a desktop computer system (e.g., 9 in Figure 1). *Id.* at col. 4, ll. 7-10.

Figure 5 shows a display screen for constructing a configuration file using a desktop computer system. *Id.* at col. 2, l. 65-67; col. 5, ll. 56-66. In web page editing screen 500, a user enters a website address in a URL window 515 and then selects the "submit" button in order to access the website for use. *Id.* at col. 5, ll. 61-63. Upon accessing the web page, the website is broken down into its component portions by system server 2 and transmitted back to desktop computer system 9. *Id.* at col. 6, ll. 11-13. As is shown in editing page 500, these portions are listed as elements 505. *Id.* at col. 6, ll. 13-16. A target screen 570 provides a simulation of display screen 10 of handset 6 and depicts what a user will actually see in real size thereon. *Id.* at col. 6, ll. 16-19. In order to remove an element from target screen 570, a user selects the delete button 510 associated with that element. *Id.* at col. 6, ll. 21-23. Thus, in this manner a user may select various portions of one or more websites to be included in the target screen 570. *Id.* at col. 6, ll. 23-25.

If, after selecting various web page elements to be included in a particular configuration file, a user wishes to further edit and manipulate these elements, control is passed to source detail view 212 (Figure 2) and

then a display such as that shown at Figure 6 is depicted to the user. *Id.* at col. 6, ll. 34-38.

In addition to editing, generating or otherwise manipulating configuration files via desktop computer system 9, it is possible to perform similar manipulations using handset 6 (or to provide similar graphical interface technology on desktop computer system 9 or other access device). *Id.* at col. 7, ll. 48-52.

In an alternative embodiment, a modified display for handset 6 may be provided. *Id.* at col. 7, ll. 56-57. Figure 3 shows a display screen 322 of a configuration file editing platform for handset 6 using WYSISYG (What You See Is What You Get) type editing in accordance with this alternative embodiment. *Id.* at col. 7, ll. 57-60. The screen is divided into five portions 324, 326, 328, 330 and 332, of which portion 332 is a screen header that includes general information, such as an indication that the screen pertains to a configuration editor. *Id.* at col. 7, ll. 60-64. Portions 324-330 are used to provide "drag and drop" style editing by letting the user drag and drop images, HTML tables, hypertext links, applets, etc. from one portion of display screen 322 to another. *Id.* at col. 7, ll. 64-67. More specifically, the user may select particular items from portions 326, 328 and 330, which represent the contents of various previously selected web pages, and may drag and drop the items into portion 324, which represents the contents of the user's configuration file. *Id.* at col. 7, l. 67 to col. 8, l. 5.

Upon completion of configuration file editing by desktop computer system 9, by handset 6, or by another access device, the configuration file is transmitted to system server 2 to verify any hypertext links that are embedded in the file. *Id* at col. 8, ll. 20-24. Once all hypertext links are verified, system server 2 stores the configuration file in database 205 on database server 8, recording user actions for arranging the elements on the source page and the template page. *Id.* at col. 8, ll. 24-26. Once the configuration file is stored in database server 8, the system is prepared to honor information requests utilizing this configuration file. *Id.* at col. 8, ll. 31-33.

Appellants do not challenge the Examiner's finding that Sugiarto's Figures 3 and 5 each show a graphical user interface that includes a "source page" (namely, screen portions 326, 328, and 330 in Figure 3 and screen 500 in Figure 5) and a "template page" (namely, screen portion 324 in Figure 3 and screen 570 in Figure 5), as recited in the first step of claim 1. Final Action 3. Nor do they question the Examiner's finding that Sugiarto discloses the second claimed step (i.e., "identifying elements within the information displayed on the source page and the template page"). *Id.*

WHETHER SUGIARTO DISCLOSES "RECORDING USER ACTIONS FOR ARRANGING THE ELEMENTS ON THE SOURCE PAGE AND THE TEMPLATE PAGE"

Appellants dispute the Examiner's finding that Sugiarto discloses "recording user actions for arranging the elements on the source page and

the template page." As noted at Brief page 10, the Examiner held that "Sugiarto clearly teaches recording user actions (i.e. user manipulation of elements on the source pages and the template page)(column 6, lines 10-40 [(Fig. 5)] & columns 7-8, lines 55-30) (Fig. 3), wherein the user actions were being recorded into memory of the configuration file." Final Action 7. In the Answer, the Examiner further explained that

> [t]he user actions included selecting and manipulating elements of a source page and adding and deleting said elements from said source page onto a template page. The recorded user actions are clearly stored in the saved configuration file, which represents the end result of the user's actions. Thus if a user selects an element from a source page and drags and drops said element onto the template page, the element in the template page becomes the saved user's action in the configuration file (i.e. the element could not exist in the template page if it had not been placed there by a user action and saved).

Answer 8.

Appellants argue that "[w]hile a user may 'manipulate' a portion of a website to be saved, Sugiarto does not teach or suggest that the various user actions are 'recorded for arranging elements on the source page and the template page'" (Br. 10) and that "Sugiarto does not teach or suggest recording user actions, such as in two stacks, which serve as the basis for supporting unlimited redo/undo tasks." *Id.* This argument is unpersuasive because the term "user action" is not defined in the Specification and therefore must be given its broadest reasonable interpretation consistent with Appellants' disclosure. *In re Thrift*, 298 F.3d 1357, 1364 (Fed. Cir. 2002).

Appellants have not demonstrated that the claim phrase "recording user actions for arranging the elements" cannot reasonably be read on recording the user's actions (e.g., keystrokes) or effects thereof when using the screens of Figures 3, 5, and 6 to select web page elements for display and to edit or manipulate the selected elements.

WHETHER SUGIARTO DISCLOSES "GENERATING THE SET OF TRANSFORM RULES FOR THE SOURCE PAGE ACCORDING TO THE SOURCE PAGE URL"

Claim 1 also recites "generating the set of transform rules for the source page according to the source page URL, the XSLT, and the receiving device." The Examiner reads the recited "generating the set of transform rules for the source page according to the source page URL" on Sugiarto's disclosure that "a user enters a website address in a URL portion 515 [Fig. 5], and then selects the submit button in order to access the website for use." Sugiarto, col. 5, ll. 61-63.[4]

In response to Appellants' argument that "[t]he Examiner has not explained how merely gaining access to a website equates to 'generating the set of transform rules for the source page according to the source page URL'" (Br. 11-12), the Examiner stated: "Clearly the transform rules for the source page utilize the source page's URL to access said source page and

[4] The Examiner's reliance on Jamtgaard for the recited XSLT is discussed *infra*.

thus the selected content elements from the source page. Without the source page URL, the transform rules of Sugiarto would have no idea where elements to be transformed existed." Answer 8-9. This position of the Examiner appears to be consistent with Sugiarto's disclosure that the configuration file is transmitted to system server 2 to verify any *hypertext links* that are embedded in the file. *Id* at col. 8, ll. 20-24. Appellants (who did not file a Reply Brief) have not addressed the Examiner's above reasoning on this point, let alone demonstrated that it is erroneous.

WHETHER JAMTGAARD TEACHES OR SUGGESTS GENERATING A SET OF TRANSFORM RULES ACCORDING TO THE XSLT

Jamtgaard discloses a system and method for delivering Web-based content, commerce, enabling transactions, and services to a variety of information appliances and devices without requiring the re-authoring of the content information for display on each of these different devices. Jamtgaard, col. 2, ll. 40-47.

The Examiner (Final Action 3) relies on two passages in Jamtgaard for a teaching of using XSL in Sugiarto. The first cited passage (quoted at page 12 of the Brief) states that compatible languages, such as Extensible Markup Language (XML), a software language designed especially for Web documents, have become much more mature and permit re-formatting of HTML or XML web pages on-the-fly to formats that individual devices can utilize. Jamtgaard, col. 2, ll. 12-17. The second cited passage (not addressed in the Brief) explains that "XSL is a language for transforming an

XML document into another XML document as described at the W3C website located at http://www.w3c.org." *Id.* at col. 7, ll. 56-58. Based on these passages, the Examiner concluded that:

> [i]t would have been obvious . . . for Sugiarto to have employed XSLT as a processing option, because Jamtgaard et al teaches that XML was a well known form of web documents to be converted for different information appliances and that XSLT was a notoriously well known standard (http://www.w3c.org) for transforming those documents to the necessary formats to be rendered on the different information appliances, all of which would have allowed Sugiarto access to all XML documents on the web for formatting and display.

Final Action 3-4.

Appellants' argument that "Jamtgaard does not teach or suggest the relevant limitation, i.e., 'generating the set of transform rules for the source page according to . . . the XSLT'" (Br. 12) is unconvincing because it is not responsive to the rationale of the rejection, which does not rely on Jamtgaard as disclosing "transform rules" based on XLST. Instead, the rejection is based on modifying *Sugiarto's* transform rules (i.e., configuration files) so as to be based in part on XLST for the reasons stated by the Examiner.

WHETHER THE EXAMINER HAS ESTABLISHED MOTIVATION TO COMBINE THE REFERENCE TEACHINGS

A. Principles of law

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In*

re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992). A rejection under 35 U.S.C. § 103(a) must be based on the following factual determinations: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) any objective indicia of non-obviousness. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966)).

"The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007)).

As noted in *Aventis Pharma Deutschland GmbH v. Lupin, Ltd.*, 499 F.3d 1293, 1301 (Fed. Cir. 2007):

> *KSR* . . . counsels against applying the "teaching, suggestion, or motivation" ("TSM") test as a "rigid and mandatory formula[]." *See KSR*, 127 S. Ct. at 1741 [50 U.S. at 418-19]. It remains necessary to show "'some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness,'" but such reasoning "need not seek out precise teachings directed to the specific subject matter of the challenged claim." *See id.* (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Specifically, *KSR* states that "the [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, 550 U.S. at 418.

See also Leapfrog, 485 F.3d at 1162 (holding it "obvious to combine the Bevan device with the SSR to update it using modern electronic components in order to gain the commonly understood benefits of such adaptation, such as decreased size, increased reliability, simplified operation, and reduced cost").

Also, a reference may be understood by the artisan to be suggesting a solution to a problem that the reference does not discuss. *See KSR*, 550 U.S. at 420-21 ("The second error of the Court of Appeals lay in its assumption that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem. . . . Common sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle. . . . A person of ordinary skill is also a person of ordinary creativity, not an automaton.").

Furthermore, the rationale for combining reference teachings is not limited to the problem the applicant was trying to solve: "[A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1380 (Fed. Cir. 2007) (quoting *KSR*, 550 U.S. at 420).

B. Analysis

Appellants argue that "[e]ven if one assumed that the combination did teach the limitations recited in the claims (which the Applicants clearly do not assume), there simply is no motivation to combine these references found within these references" (Br. 13), citing *Symbol Technologies, Inc. v. Opticon, Inc.* 935 F.2d 1569, 1576, 19 USPQ2d 1241 (Fed. Cir. 1991) for the principle that "some teaching or suggestion in the references to support their use in the particular claimed combination" is needed. *Id.* at 14 & n.49. However, this principle has been superseded by *KSR*, which as noted above held that "the [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, 550 U.S. at 418. Appellants have not identified any alleged error in the Examiner's rationale for modifying Sugiarto's configuration files in view of Jamtgaard so as to be based in part on XLST. Instead, Appellants made only the above-discussed, unpersuasive argument that Jamtgaard "does not . . . teach or suggest 'generating the set of transform rules for the source page according to . . . the XSLT.'" Br. 12.

Turning now to Keane, that reference discloses a computer system that includes a reusable isolated undo/redo service that provides application programs with an undo/redo function. Keane, col. 1, ll. 6-10. The Examiner cited Keane for a teaching of storing user actions in a redo stack and an undo stack (Keane, col. 1, ll. 32-52) and concluded that it would have been

obvious to modify Sugiarto to employ this feature "because Keane teaches by doing so a user can retrace their user actions by adding functionality to redo and undo actions (Summary of Invention)." Final Action 4.

Appellants argue that "[t]he Examiner merely cites an isolated element from Keane and summarily concludes that one would be motivated to combine that isolated element into Sugiarto," that "just because a limitation appears in a reference does not mean that a motivation to combine it with another reference exists," and that "[w]hile the Examiner offers an unsupported conclusion of a motivation to combine Keane with Sugiarto, it is telling that the Examiner offers absolutely no cite from Keane or Sugiarto in support of this unsupported conclusion." Br. 15. These arguments are unpersuasive because they do not comport with *KSR*, which as noted above does not require that the motivation for combining reference teachings be stated in a reference. Appellants have not explained why the Examiner erred in concluding that it would have been considered desirable and therefore obvious to add Keane's redo and undo functionality to Sugiarto's process of creating configuration files (as modified in view of Jamtgaard to add XSLT).

CONCLUSION REGARDING CLAIMS 1-15

Because Appellants have not demonstrated error in the Examiner's reasoning, the rejection of claim 1 is affirmed, as is the rejection of dependent claims 2-15, which are not separately argued.

WHETHER MICROSOFT WORD 2000 DISCLOSES RECORDING "ONE USER ACTION INCLUD[ING] A KEYSTROKE" (CLAIMS 16-22)

Claims 16-22, which are separately argued, recite specific examples of the recited "user action." Claim 16, for example, reads:

> 16. The method of claim 1, wherein one user action includes a keystroke for moving the source element to an absolute x, y position.

In the first Office action, the Examiner concluded the subject matter of claims 16-22 would have been obvious over "what was notoriously well known in the art as keyboard shortcuts such as copy, paste, and cut (i.e. basic word processor functionality such as Microsoft Word 98, which encompassed the equivalent to the drag and drop functionality)." December 14, 2004, Office action at 6. In response to Appellants' traversal (March 14, 2005, Amendment at 13-14) of what they characterized as an improper taking of Official Notice, the Examiner cited Microsoft Word 2000, which the Examiner describes as "showing user keystroke actions utilizing Ctrl-C (Copy), Crtl-V (Paste), and Crtl-X (Cut) performing the claim limitations." Final Action 9.

Appellants, after correctly noting that Ctrl-C (Copy), Crtl-V (Paste), and Crtl-X (Cut) mean "copy (i.e., CTRL and C), paste (i.e., CTRL and V), and cut (CTRL and X)" (Br. 16), argue that each of these operations consists of a pair of user actions in the form of a pair of keystrokes, with the result that recording one of these operations involves recording *multiple* user actions (i.e., keystrokes) rather than recording *one* user action, as recited in

the claims. Br. 17. This argument is unconvincing because, as pointed out the Examiner (Answer 9), the recited "user action" is not defined (in the Specification in general or in the claims in particular) as limited to a *single* keystroke and thus is broad enough to read on an operation (e.g., Copy) that consists of a pair of keystrokes (CTRL and C).

Inasmuch as Appellants have not demonstrated error in the Examiner's rejection of claims 16-22 for obviousness over the prior, the rejection of those claims is affirmed.

DECISION

The rejection of claims 1-22 under 35 U.S.C. § 103(a) for obviousness over the prior art is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2008).

AFFIRMED

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